

IN THE
United States
Circuit Court of Appeals
FOR THE
Ninth Circuit

A. B. HUMPHREY COM-
PANY, (a corporation),
Appellant,

vs.

BEN H. ARKELIAN and
BEN H. ARKELIAN &
CO., (a copartnership),
Appellees.

In Equity

Claimed Infringement of
United States Registered
Trade-Mark No. 186,739,
July 22, 1924. "Lady
Fingers" for Fresh
Grapes.

Brief for Appellees

W. M. CONLEY,
PHILIP CONLEY,
MATTHEW CONLEY,
507 Pacific Southwest Bldg.,
Fresno, California,
Attorneys for Appellees.

FILED

JUN 3 1921

SUBJECT INDEX

	Page
I. Statements of Facts and Grounds for Decree.....	1
II. The Issuance of the Trade-Mark Does not Prove Appellant's Right to the Exclusive use of the Word "Lady Fingers".....	5
III. Appellees Were not Guilty of any Fraud or any Intent to Deceive.....	7
IV. Appellees Rightfully Used the Word "Lady Finger"	9
V. Prior use in America of the Name "Lady Finger" as Applied to White Grapes of a Certain Variety and Type	9
VI. Prior use in Foreign Countries of Names Which, Translated Into the English Language, Mean "Lady Fingers" as Applied to White Grapes of the Variety and Type Grown and Sold in This Country.....	15
VII. The Name is Generic in Meaning.....	16
VIII. The Name has Been and now is Applied to the Parent Stock, and the Words are Rightfully Used to Characterize the Product of the Parent Stock	20
IX. Laches on the Part of Appellant, in any Event Prevent a Recovery by it.....	24
X. Conclusion	29

TABLE OF AUTHORITIES

Amoskeag Mfg. Co. v. Spear, 2 Sandf. 599.....	19
Corbin v. Gould, 133 U. S. 308, 314, 33 L. Ed. 611, 613	19
Dadirrian v. Yacubian, 72 Fed. 1010.....	16
Dadirrian v. Yacubian, 90 Fed. 812, Aff. 98 Fed. 872	16

	Page
Delaware & H. Canal Co. v. Clark, 13 Wall. 322, 20 L. Ed. 883	8
Durton v. Stratton, 12 Fed. 696, 701.....	19
Ford v. Foster, L. R. 7 Ch. 628, 41 L. J. Ch. N. S. 682	28
Hoyt v. Lovett, 71 Fed. 173.....	22
Italian Swiss Colony v. Italian Vineyard Co., 158 Cal. 252, 32 L. R. A., N. S., 439.....	8, 16
La Republique Francaise v. Saratoga Vichy Springs Co., 191 U. S. 427, 441, 48 L. Ed. 247.....	8, 27
Layton Pure Food Co. v. Church & Dwight Co., 189 Fed, 24, 34.....	8
Luyties v. Hollendeer, 30 Fed. 632.....	16
Metcalf v. Hanover Star Milling Co., 204 Fed. 211, 216	10
National Starch Mfg. Co. v. Munn's Patent etc. Co., (1894) A. C. 275.....	28
Saxlehner v. Eisner & M. Co., 179 U. S. 19, 45 L. Ed. 60, 75	28
The Liggett & Myers Tobacco Co. v. B. Finzer, 128 U. S. 182, 189.....	8

IN THE
United States
Circuit Court of Appeals
FOR THE
Ninth Circuit

A. B. HUMPHREY COM-
PANY, (a corporation),
Appellant,

vs.

BEN H. ARKELIAN and
BEN H. ARKELIAN &
CO., (a copartnership),
Appellees.

In Equity

Claimed Infringement of
United States Registered
Trade-Mark No. 186,739,
July 22, 1924, "Lady
Fingers" for Fresh
Grapes.

BRIEF FOR APPELLEES

**I. STATEMENT OF FACTS AND GROUNDS
FOR DECREE.**

The statement of facts contained in Brief for Appellant is incomplete and misleading; it sets forth in considerable detail the evidence relied upon by appellant, but does not state fully the conflicting evidence upon which the decree was based. It will therefore be necessary to make herein a brief statement of the facts.

For over forty years a common and well known variety of grapes, known as "Lady Finger" grapes have been grown and produced in the San Joaquin Valley and other sections of the State of California, and have been shipped and sold in the local markets of California and in the markets of eastern states. This variety of grapes is also grown and produced in Europe. The term "Lady Fingers" was applied to these grapes in California as early as the year 1884, and at the present time, and for many years last past, many persons are producing and selling these grapes in the markets of California and of the eastern states. Among the producers and shippers of these grapes are the defendants in this suit.

Lady Finger grapes are long and thin and whitish in color, and quite attractive, and meet with ready sale not only in California but elsewhere. The variety is as well known as many of the other varieties of grapes grown and produced in California; it is a variety or type of grape, in the same sense that Muscats, Malagas, Thompson Seedless, Fresno Beauties, Zinfandels and Missions are varieties or types. Lady Finger grapes are also grown and produced in Turkey and Dalmatia. In Turkey the grape is called "Hanam Parmaghy," which, translated into the English language, means Lady Finger; and in Dalmatia by the Slavonic-Italian name of "Gospodji Perst," which in English, means Lady Finger or Lady's Finger.

Lady Finger grapes was the commonly used name of this particular type of grape long prior to the time when the appellant claims that A. B. Humphrey adopted the name "Lady Finger" as an arbitrary

trade-mark for fresh grapes, and long before the predecessor of this appellant started to grow or produce this variety of grapes in California.

The appellant claims that A. B. Humphrey, its predecessor in interest, produced a variety of grapes which he named "Lady Fingers" as early as the year 1895, and that the said A. B. Humphrey produced and sold these grapes under the name of Lady Finger each year until the year 1927; that on or about the 6th day of September, 1927, the said A. B. Humphrey assigned his interest in the alleged trade-mark to A. B. Humphrey Company, a corporation; that subsequent to this assignment the corporation continued to produce and sell these grapes under the name of Humphrey's Lady Fingers, also. Upon these alleged facts appellant sought an injunction to prevent appellees from selling or offering for sale any of their grapes as "Lady Finger Grapes." The case was tried before Hon. A. F. St. Sure, United States District Judge, in the District Court, and a decree was subsequently entered denying plaintiff any relief whatever and adjudging that the trade-mark claimed by plaintiff and appellant registered in the patent office, and the certificate of registration thereof, were void and of no force or effect.

In its brief, appellant says: "No opinion was rendered so we are left in doubt as to the grounds for the decision." An inspection of the record will at once disclose that there can be *no doubt* as to the reasons for the decision and decree in this case. Indeed, under the evidence adduced at the trial of the case, no other decision or decree was possible. The trial court heard the testi-

mony of the witnesses and had the opportunity to test and determine their credibility and examine the exhibits and other documentary evidence introduced, and after due consideration of all the evidence in the case determined that the contentions of plaintiff and appellant were without merit, and ordered a decree for the defendant. We confidently assert that upon a full consideration of the entire record in the case, the following conclusions must necessarily be reached:

1. That the name "Lady Finger" or "Lady Fingers" is a common and well known name applied to a certain variety of grapes which has been grown in California and shipped and sold for over forty years;

2. That the name "Lady Finger" or "Lady Fingers" as applied to the variety of grapes described in the pleadings is generic, and cannot be appropriated as a trade-mark because it is too general and comprehensive in its meaning to become the monopoly of any single individual in its application to grapes;

3. That long before plaintiff's predecessor in interest made application to register his trade-mark, Lady Finger grapes were well known to the producers and purchasers of grapes in California and other states, and in Europe, and the term "Lady Fingers" has for many years been the common and commercial name for these white grapes, and that the name was so applied by the producers in the State of California to these grapes with the knowledge, acquiescence and consent of this plaintiff and its predecessor;

4. That plaintiff and its predecessor well knew for many years prior to the institution of this action that

other persons were growing, producing and selling the same variety of grapes that appellant and its predecessor were growing and producing on their vineyards, under the name of Lady Finger grapes, and that appellant and his predecessor permitted, this to be done without making protest or objection of any kind or character to the growers and vendors of said grapes. That under these circumstances plaintiff should not be allowed or permitted, after sleeping on its alleged rights for nearly thirty-three years, to prevent these defendants, as growers and shippers, from disposing of the results of their energy, enterprise and labor and from using the common and well known name by which these grapes are grown, shipped and sold. To grant the relief prayed for would be to give this plaintiff a monopoly in the production and sale of all grapes grown in California of the variety known as Lady Finger grapes;

5. That a decision enjoining defendants from labeling or selling their grapes under the name "Lady Fingers" would probably induce others to attempt to appropriate as trade-marks the names of other well known varieties of grapes on the asserted ground that they were the first to have given the name to varieties that are now well known in this state.

II. THE ISSUANCE OF THE TRADE-MARK DOES NOT PROVE APPELLANT'S RIGHT TO THE EXCLUSIVE USE OF THE WORD "LADY FINGERS."

In order to register a valid trade-mark at Washington, it is, of course, necessary to follow the laws of the United States in this regard. Upon filing the ap-

plication with the Commissioner of Patents and the payment of the fees, the Commissioner causes an examination to be made, and if upon such examination it shall appear that the applicant is entitled to have his trade-mark registered, the Commissioner shall cause the mark to be published at least once in the official gazette of the patent office. (The Code of Laws of the United States of America, Title 15, Chapter 3 of Trade-Marks.)

As a matter of fact the official gazette of the patent office is probably read only by a few patent attorneys in or about Washington, and it is quite likely, in the same circumstances, that, if someone applied for a trade-mark on Mission grapes, or any other variety of grapes grown in the San Joaquin Valley, a certificate of registration of trade-mark would issue. This registration is only *prima facie* evidence of ownership, and is by no means conclusive.

In all probability, the investigation as to the validity of this particular application for trade-mark, was made by someone not familiar with the grape growing industry of this state, because if any particular pains had been taken a reference to *Webster's New International Dictionary and Encyclopedia of the English Language*, published in 1920 by C. & G. Merri-man Company, Springfield, Massachusetts, and the numerous publications issued in this country describing the varieties of grapes grown and produced in California, would have disclosed that Lady Finger was the name of a well known variety of grapes grown, produced and shipped from California for sale in the eastern markets, and that the term "Lady Finger" as ap-

plied to grapes was used long before the appellant or A. B. Humphrey, its predecessor, was engaged in the production and sale of grapes,—probably long before A. B. Humphrey was born. There can be no doubt that if a thorough and proper investigation had been made by the Commissioner's office, the application for a registration of the trade-mark would have been denied.

III. APPELLEES WERE NOT GUILTY OF ANY FRAUD OR ANY INTENT TO DECEIVE.

The only question involved in this case is whether or not the appellees are entitled to use the word "Lady Finger" in connection with their advertising and on their Enchantress brand labels. There is no question of any imitation by appellees of appellant's labels, and it is clear that there was no intent whatsoever to deceive the public by the use of the Enchantress brand labels.

The Enchantress brand labels and the Humphrey labels are totally different in size, shape, color and device. During the trial of the action, the Court said:

"I don't see how they would be likely to be deceived by that Enchantress Label. The only issue here is as to the use of the word "Lady Fingers." (R. 48 and 49.)

"Well, the only deception, if any, would be the use of the word "Lady Finger." Wouldn't that be so? There is no similarity whatever between the Enchantress label and the label you use, is there? So that the only deception, if any, would be the use of the word "Lady Finger." (R. 49.)

The labels were introduced in evidence and they speak for themselves. The evidence of the eye is more

persuasive and satisfactory than any other on the question of intent to deceive by the use of labels or brands.

Layton Pure Food Co. v. Church & Dwight Co.,
189 Fed. 24, 34;

The Liggett & Myers Tobacco Co. v. B. Finzer,
128 U. S. 182, 189.

The law affords protection against the unfair competition of any one who seeks by the imitation of label or package or other artifice, to induce persons to deal with him in the belief that they are dealing with another. (*Italian Swiss Colony v. Italian Vineyard Co.*, 158 Colo. 252.) However, in such situation, there must exist the intent to deceive, or at least the doing of acts reasonably calculated to deceive. In the absence of such intent and of such acts, recovery by plaintiff is precluded. In the opinion in *La Republique Francaise v. Saratoga Vichy Springs Co.*, 191 U. S. 427, at page 441, the Supreme Court states:

“It was said by this court in *Delaware & H. Canal Co. v. Clark*, 13 Wall. 322, 20 L. Ed. 883, ‘In all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and that it is only when false representation is directly or indirectly made that the party who appeals to the court of equity can have relief.’ Applying this doctrine to the case under consideration, we are clearly of the opinion that there is no such similarity in the labels as at present used, and that there is no such fraud shown in the conduct of the defendant as would authorize us to say that plaintiffs are entitled to relief.”

In the case at bar, appellees have not been guilty of any fraud or of any intent to deceive, as they have not

been selling or trying to sell their Lady Finger grapes as those of plaintiff. This is clearly shown by the entire evidence in the case, the labels themselves, and the statements of the trial court above referred to. The only question involved is whether or not the mere use of the word “Lady Finger” by appellees is legally improper.

IV. APPELLEES RIGHTFULLY USED THE WORD “LADY FINGER.”

The decision of the lower court should be affirmed for all of the following reasons:

1. Prior use in America of the name “Lady Finger” as applied to white grapes of a certain variety and type. The evidence in the record clearly shows that before appellant’s predecessor ever used the term, the word “Lady Fingers” was used in the grape growing districts of California.

2. Prior use in foreign countries of names which translated into the English language mean “Lady Fingers” as applied to white grapes of this variety and type grown and sold in foreign countries.

3. The name is generic in meaning.

4. The name has been and now is applied to the parent stock, and the words are rightfully used to characterize the product of the parent stock.

5. Laches on the part of appellant, in any event, prevent a recovery by it.

V. PRIOR USE IN AMERICA OF THE NAME “LADY FINGER” AS APPLIED TO WHITE GRAPES OF A CERTAIN VARIETY AND TYPE.

Appellees contend that they have never infringed

upon the trade-mark of the appellant, for the reason that appellant has never had a valid trade-mark. The evidence shows that defendants started to grow Lady Finger grapes in the year 1920, and did not ship them until the year 1921 or 1922, when the vines planted in 1920 came into production. However, Lady Finger grapes were shipped by other persons than appellees in large quantities in 1916, 1917 and 1918 (testimony of W. Flanders Setchell, R. 87), and Lady Finger grapes were sold in Fresno as early as thirty-five years prior to the trial of this action, as testified to by Joseph Arkell. (R. 103.)

Before there can be any infringement of a trade-mark, it should appear by a clear preponderance of evidence that the appellant was the first to appropriate the mark or symbol, and his exclusive use depends upon prior appropriation. (See *Metcalf v. Hanover Star Milling Co.*, 204 Fed. 211 at 216.)

K. Arkelian, a witness for defendants, testified that in 1883 he was acquainted with the variety of grapes known as "Lady Finger" grapes; that he saw this variety of grapes when he first came to Fresno and picked grapes on the Eisemann Vineyard; that it was grown on the said vineyard at that time under the name of "Lady Fingers"; that the foreman of the ranch called them "Lady Fingers." (R. 96, 97, and 98.)

Joseph Arkell, witness for defendants, testified that between thirty-five and thirty-eight years prior to the trial of this action, which would be about 1893, and which would be prior to the time appellant's predecessor in interest claims that he named the so-called "Lady

Finger” grapes, that the witness purchased these grapes on the Margarita Vineyard near Fresno and sold the grapes as “Lady Finger” grapes; that when he went to buy these grapes, he asked for the long, white grapes and the foreman of the Margarita Vineyard said, “Lady Fingers?”; that he learned from the foreman there that the name of the variety he wished was “Lady Fingers” (R. 103, 104, and 105); that he stopped peddling grapes when he was 19 or 20 years old and that it was over thirty-five years prior to the trial of this action when he first purchased these “Lady Finger” grapes. (R. 106.)

Mark Cosulich testified as follows: (R. 101, 102.)

“Question by Mr. Loftus: But the first time you heard the name ‘Lady Fingers’ in this country was in 1917 or ’18, was it?”

A. No. I heard that when I lived in Fresno in 1897 and 1898, before I was ever engaged in the grape shipping business.”

One of the defendants, Ben H. Arkelian, testified that he first saw this variety of grapes growing in the Eisemann Vineyard; that he was forty-three years of age at the time of the trial of this action; that when he first saw this variety of grape he was approximately ten years of age and that his father told him the name of the said grape; that the father translated the Turkish or Armenian word meaning “Lady Finger.” (R. 106.)

From the testimony of these four witnesses for defendants, it is clearly seen that the word “Lady Fingers” was the name of a well-known type or variety of grapes grown in the State of California before the appellants in this action, or their predecessor in interest,

adopted that name. The preponderance of evidence is against the contention of plaintiff that its predecessor in interest was the first to appropriate the name to his exclusive use.

The brief of appellants endeavors to discredit the testimony of these four witnesses by characterizing it as unsatisfactory and unreliable. However, these witnesses testified before Judge St. Sure in open court and he had every opportunity to determine whether or not their testimony was reliable and satisfactory or otherwise. The trial court rendered its decision in favor of the appellees, and that fact alone should be sufficient to overcome any objection on the part of the appellants as to the weight of this testimony. The trial judge saw and heard the witnesses testify in open court and he was satisfied with the truth of their statements.

The same observation should be made with reference to the claim by appellant concerning the testimony of witnesses adduced by it, conflicting with the above mentioned evidence. Appellant asks that the testimony of defendants' witnesses with regard to the Lady Finger grapes grown on the Eisemann Vineyard should be disregarded because there was some negative testimony on this subject by plaintiff's witnesses. A portion of Mr. Humphrey's testimony is referred to, in which he states that at one time he visited the Eisemann Vineyard and did not then see any Lady Finger grapes. Obviously, Mr. Humphrey cannot refute the positive testimony of appellees' witnesses by stating that he himself had never seen or heard of a Lady Finger grape in this particular vineyard. Mr. Humphrey

also testified that he had been on the Arakelian Vineyard near Bakersfield, and that upon that occasion grape vines were pointed out to him as Lady Finger vines, but that he himself could not tell whether they were vines of this variety, using as an excuse that the vines were too young. (R. 53.) How, then, could Mr. Humphrey be qualified to state positively that there were no Lady Finger grapes on the Eisemann Vineyard when there were 250 varieties of grapes grown there? (R. 121.)

Stress is also laid on the testimony of Edward I. Baber, who was formerly manager of the Eisemann Ranch, to the effect that there was never a grape on the Eisemann Vineyard known as the "Lady Finger" grape. Baber admitted, however, in his testimony that some white Cornichon grapes were grown on the Eisemann Vineyard (R. 114); that a grape called "Palomino Blanco" a long, oval-shaped grape of the Malaga family, was grown on the premises (R. 115) and that he had heard the name "Lady Finger" applied to grapes somewhere between the time he was on the vineyard from 1880 to 1916. (R. 117.)

The evidence shows that Mr. Humphrey's particular vine which is also known as the "Rish Baba," is not the only grape commonly called "Lady Finger." This name is applied to several varieties of grape, among them the Rish Baba, the white Cornichon, Pizzutello di Roma, Olivette Blanche and the Khandahar. (R. 143.) All of these grapes are of a long, slender, white variety, with thin skins and firm meat, which is, at the same time, somewhat brittle and crisp. From

a vineyardist's standpoint, each grape perhaps varies slightly from the other, but from the ordinary retail purchaser's standpoint, they are all one type or class of grapes, known as "Lady Finger" grapes. Because Mr. Baber personally did not call these white grapes grown on the Eisemann Vineyard "Lady Finger" grapes, appellant seeks to discredit the entire testimony of appellees' witnesses.

Attention is also directed by appellant to the testimony of its witness, S. A. Lines, to the effect that he never saw or heard of any grapes called "Lady Finger" grapes on the Eisemann Vineyard and that he never heard of any "Lady Finger" grapes being grown on the Margarita Vineyard. Mr. Lines also testified that he has been connected with the Earl Fruit Company since 1902 or 1903; that he was local agent for the Earl Fruit Company at Fresno; that he never saw Lady Finger grapes for sale in Fresno (R. 122, 124); and that there were no grapes shipped by the Earl Fruit Company under the name "Lady Finger" to the knowledge of the witness. (R. 124, 125.)

Mr. Lines' testimony is rebutted by W. Flanders Setchel, who states that the Earl Fruit Company shipped Lady Finger grapes from the Frank H. Wilson place between the years 1916 and 1921. (R. 144, 145.)

Mr. Lines' testimony is essentially negative; his statement that he did not know of the growing of Lady Finger grapes in certain vineyards does not show that they were not in fact grown there. (R. 124, 128.)

It is therefore apparent that the trial court had before it ample evidence (conflicting, it is true, with evi-

dence adduced by appellant) to the effect that the term "Lady Finger" was applied to grapes of this variety and type in California even before the appellant's predecessor began to use the term as applied to grapes grown by himself.

VI. PRIOR USE IN FOREIGN COUNTRIES OF NAMES WHICH TRANSLATED INTO THE ENGLISH LANGUAGE MEAN "LADY FINGERS" AS APPLIED TO WHITE GRAPES OF THIS VARIETY AND TYPE GROWN AND SOLD IN FOREIGN COUNTRIES.

The record also clearly shows that in Turkey and in Dalmatia the words meaning "Lady Finger," in Turkish and in the Slavic language, were applied to this type and variety of grape many years before Mr. Humphrey began to use the term.

K. Arkelian, witness for defendants, testified that many years ago he was acquainted with this grape at and near Constantinople; that it was called in Turkish "Hanan Parmaghy," the translation of which into the English language is "Lady's Finger;" that he saw this variety of grape in Turkey in 1895 and bought some there in the month of August, 1895. (R. 96, 97.)

Mark Cosulich, a witness for defendants, testified that he was fifty years old in March, 1928 (R. 102); that when he was nine or ten years of age he made a visit to the city of Spalato in Dalmatia; that he went to a market there and saw these peculiar grapes; that the name of the grapes was "Gospodje Perst," which, in the English language, means "Lady Fingers." (R. 101.)

In connection with the reporting of the case of *Italian Swiss Colony v. Italian Vineyard Company*, [158 Cal. 252,] 32 L. R. A., N. S., at page 439, contains a note which reads in part as follows:

“No person is entitled to be protected in the use of a trade-mark of a word or phrase descriptive of the article to which it is applied; and by the great weight of authority, the fact that the word is a translation into English from a foreign word properly descriptive of the article in the language of the country in which it is produced, gives no greater right to its use as a trade-mark.”

Luyties v. Hollendeer, 30 Fed. 632;

Dadirrian v. Yacubian, 72 Fed. 1010;

Dadirrian v. Yacubian, 90 Fed. 812, affirmed 98 Fed. 872.

VII. THE NAME IS GENERIC IN MEANING.

From the foregoing testimony it appears beyond a doubt that the name “Lady Finger” was used to designate a well-known type or variety of grape long before Mr. Humphrey ever adopted or used it. Mr. Humphrey claims that he named his grapes “Lady Fingers,” because of the shape of the bunch and the shape of the grape, and that when he first saw a bunch of these grapes the name immediately suggested itself to him. (R. 35, 36.) Even if this testimony should be accepted at its face value, it is not unreasonable to suppose that the same descriptive term occurred many years ago to the Turks and Dalmatians who grew this type of grape, and to other California growers who likewise produced it.

Lady Finger is a name which is descriptive, and generic in its nature and is the appropriate name to

be applied in California and the United States to this type of long, slender, white grape; this name was applied to this grape before its use by Mr. Humphrey, both in foreign countries and in the United States. We have already referred to the fact that Webster's New International Dictionary defines "Lady Finger" as a variety of grape. The record shows that "Lady Fingers" are referred to and described as a variety of grape in various scientific horticultural works and in catalogues of nurseries. It is so listed in "California Horticulture" by George C. Roeding, copyrighted in 1909 (R. 82); one of the witnesses, W. Flanders Setchel, testified that he purchased a copy of this work in the early part of 1911 in Fresno. (R. 85). A similar entry was made in Armstrong's Catalogues (R. 81). There was also an entry of the term "Lady Fingers" as a variety of grape in the catalogues of the Fancher Creek Nurseries (R. 134).

The California Fruit, Nut and Vegetable Standardization Act of 1927, lists "Lady Finger" as a variety of grapes, and makes provisions and regulations relative to the shipment of the same under that name. The witness F. de Journal, an attorney, who owned and shipped Lady Finger grapes, testified that he was required by the Horticultural Commissioner of California to ship said grapes under that name. (R. 93).

The following evidence of Ben H. Arkelian is uncontradicted relative to the handling of Lady Finger grapes by him and the regulations enforced concerning the same:

"A. The Government lists them on their market report. The county or the state inspection

bureau writes certificates and calls them 'Lady Fingers.' Our County Horticulturist at Modesto, as well as Bakersfield, insists that we put the word 'Lady Finger' on the box because they are a 'Lady Finger' grape." (R. 112).

Mr. Humphrey himself, in portions of his testimony, seems to recognize that the word "Lady Finger" is descriptive of a variety or type of grape rather than an invented or trade name. This is indicated by the fact that on his labels he at all times emphasized the word "Humphrey;" his labels bore the words "Humphrey's Lady Fingers." (R. p. 47). The witness also testified:

"The Witness.—We ship our grapes in cars, in lugs, and brace them. Five or six years ago they were all crates. We have gradually changed until we ship almost all lugs. It is a modification of the Los Angeles lug. They have covers on them. Since I got the trade-mark, I place the label on the top side of the cover. Before that I stamped them on the end of the box 'Lady Finger' with a rubber stamp. I do the same thing with other varieties that I produce—Tokay, Cornichon, Emperor, and Malagas. I started doing that long before there was any Fruit and Vegetable Standardization Act; have done it for 38 years." (R. 58, 59).

If the word "Lady Fingers" were in fact recognized by appellant and its predecessor as an unique trade name meaning grapes of a certain type grown by appellant and its predecessor, it would scarcely have found it necessary constantly to emphasize the word "Humphrey" in connection with his labels.

Under the authorities it is clear that a generic name can not be exclusively adopted and appropriated by an

individual, and it is of course a question of fact to be determined from the evidence whether or not the name is a generic term. In the case of *Corbin v. Gould*, 133 U. S. 308, at page 314, (33 L. Ed. 611, 613) it is said:

“At the time complainants claim to have adopted the word ‘Tycoon’ as their trade-mark, for the particular species of tea dealt in by them, it was not an abandoned trade-mark previously used by some other person or firm to designate a particular quality of tea; but it was, and had been for many years, in general and common use as a term descriptive of a class of teas introduced into the American market—a term which all men engaged in the tea business had an equal right to use, and which belonged to no one individual either as a trade-mark or a trade label. It belonged to the public, as the common property of the trade, and therefore was not subject to appropriation by any one person. The following language used in *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. 599, quoted with approval by this court in *Delaware & H. Canal Co. v. Clark*, 80 U. S. 13 Wall. 311, 324 (20: 581, 583), is applicable to the claim of the complainant in this case: ‘He has no right to appropriate a sign or a symbol (or a name,) which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose.’ ”

In *Durton v. Stratton*, 12 Fed. 696, 701, it is said:

“The difficulty is in distinguishing cases where the property has acquired a generic name, as indicating the quality of the article rather than its origin or ownership . . . The only satisfactory rule we have been able to gather from the authorities is that in each case it is a matter for the court to determine, not alone from the mark itself, but from the testimony, whether the words have become so well known as to stand in the pub-

lic eye as denoting the character and quality of the article and not its origin or ownership. Thus, if it should appear that the article had been manufactured and sold by a number of dealers under a particular name, this would be decisive that the plaintiff had no right to the exclusive use of that name. Most if not all of these generic names were at first indicative of the origin, but finally, by constant use, ceased to subserve that purpose and have become indicative of a quality. An example of this is 'Fowler's Solution of Arsenic,' which clearly indicates origin, but the article is nevertheless put up by druggists all over the country, and this name has become public property. We think that most if not all of the cases upon this subject, when carefully examined will be found to have turned upon the extent to which the name is used, rather than upon the name itself. Thus, in the *A. C. A. Case*, 101 U. S. 51, it was said by the court that it was clear from the history of the adoption of the letters as narrated by the complainant and the device itself, that they were only intended to represent the highest quality of ticking manufactured by the plaintiff, and not its origin. It appeared that other letters were used to indicate inferior grades of the same article."

Mr. Humphrey had no right to a trade-mark of the name "Lady Fingers" for he was attempting to adopt a commonly known name of a variety or type of grapes.

VIII. THE NAME HAS BEEN AND NOW IS
APPLIED TO THE PARENT STOCK AND
THE WORDS ARE RIGHTFULLY USED TO
CHARACTERIZE THE PRODUCT OF THE
PARENT STOCK.

In the event that a tree or vine is commonly called by a distinguishing name, the product of such tree or vine may rightfully be called by the same dis-

tinguishing name. From a reading of the entire record in the case, the inference can be drawn that the name given by Mr. Humphrey to the vine which produced his grape was the "Lady Finger" grape-vine. It is common knowledge in California that the name of the vine and the name of the grapes grown on it are identical,— thus, Muscat grapes are grown on a Muscat grape vine, Malagas on a Malaga vine, Zinfandels on a Zinfandel vine, etc.

The witness Humphrey testified that he had been a vineyardist for many years, interested in the growing of grapes and in experimenting with various varieties of grapes; that when he first saw the shape of a bunch of grapes and the grapes themselves grown on a vine which he had planted, he immediately named the grape "Lady Finger." (R. 35, 36).

The witness also testified that he presented various persons who applied therefor with two cuttings of this grape vine (R. 41); that he followed this practice for many years after 1895; that he presented these cuttings to all applicants and that on the average he gave these cuttings to from three to six persons each year. (R. 51). Mr. Humphrey states that he notified these people to whom he gave cuttings that they must not use the word "Lady Fingers" as applied to the grapes produced, (R. 51) but it does not appear when this alleged notification took place. Neither does it appear that Mr. Humphrey had any contract of any kind with the persons to whom he gave the grape cuttings to the effect that they could not use the word "Lady Fingers" in shipping grapes grown from these cuttings, and it

may be inferred that Mr. Humphrey has only comparatively recently attempted to force an agreement with such persons, presumably by notifying them that he will sue to enjoin the use of the word “Lady Fingers” if they shipped grapes under that name.

It is not unreasonable to believe that Mr. Humphrey gave away these many grape cuttings by reason of his pride in the stock, and that no strings were attached to the gifts themselves until after he had consulted attorneys in about the year 1924 and was advised by them that he might seek to secure as a trade-mark the name “Lady Fingers” and thus eliminate competition in eastern markets. The origin of part of the Lady Finger grape vines owned by appellees is traced back directly to the original stock as shown by the following testimony:

“Q. Do you know where they came from?”
(Indicating Lady Finger grapes grown on the Arkelian place).

“A. Yes. Some of the vines I got were off some brush that Mr. Humphrey had given these people. They originally came from Mr. Humphrey’s ranch,—that he had given away . . .

Mr. Conley.—Q. Did Mr. Humphrey ever attempt . . .

A. (Continuing.)—and I think I got some from the seed farm at Davis.”

A portion of the opinion in *Hoyt v. Lovett*, 71 Fed. 173, reads as follows:

“The remaining objection to the bill is that the protection of a trademark cannot be obtained for an organic article which, by the law of its nature, is reproductive and derives its chief value from its innate vital powers, independently of the care,

management, or ingenuity of man. This question is conceded to be novel and unprecedented. Tested, however, by the general principles regulating sales of personal property, there is no doubt that a sale of seeds, plants or vines, when detached from the soil in which they grew, carries with it, on delivery, the right of property in the buyer, not only in the article so bought, but also in the natural increase or products of the same when sown or replanted. Neither the common law nor the statutes relating to trademarks extend the protection of tradenames to things which are valued more for their natural powers of reproduction and increase than for any other qualities. The facts in the present case afford an apt illustration of the incongruity of a contrary doctrine. A man buys a grapevine, to which is attached a metallic label stamped with the trademark of the seller. In the absence of a special contract between the parties, what is to prevent the buyer from cultivating the vine, and selling its products, whether of wood or of fruit, under the name of the parent stock? Certainly not a trademark. To repeat the words of Mr. Justice Strong: 'No one can obtain protection for the exclusive use of a trademark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself.'

"The Hoyts did not make the Green Mountain vine, nor, strictly speaking, did they produce it. It grew out of the earth, was fashioned by nature, and endowed with powers and qualities which no human ingenuity or skill could create or imitate. If such protection as that now claimed by the complainants was allowed, a breeder of cattle could with equal propriety and reason demand like protection for the natural increase of his herd. In every aspect such claims would seem to be impracticable and inequitable."

It would appear from the Hoyt case that even though Mr. Humphrey might originally have applied for a trade-mark based upon the name "Lady Finger," he lost the right to that trade-mark for the reason that he gave away many cuttings without a special contract at the time to the effect that the parties growing said grapevines could not use the name "Lady Finger."

IX. LACHES ON THE PART OF APPELLANT,
IN ANY EVENT, PREVENT A RECOVERY BY
IT.

Even if it should be considered that Mr. Humphrey originally had the exclusive right to the word "Lady Finger" to designate a variety of grapes, appellant has lost that right because appellant and its predecessor failed to enforce their claim of right within a reasonable time after discovery that others were using the name "Lady Finger." Mr. Humphrey testified that he learned others were employing the name "Lady Fingers" somewhere between 1918 and 1920 (R. 39) and that he first heard the appellees were using the name within the last three years prior to the trial (R. 39)

W. Flanders Setchel stated that in 1918 in Sacramento he had a conversation with Mr. Humphrey in which the latter told him that others besides Mr. Humphrey were shipping the variety and type of grapes and using the name "Lady Finger" and that they should not do it. (R. 87 and 88). Mr. Setchel at that time told Mr. Humphrey that he had also grown Lady Finger grapes and was shipping them. (R. 88.)

We have already called the court's attention to the testimony of certain witnesses relative to the growing of Lady Finger grapes, and also to the fact that catalogues of nurserymen and treatises on horticulture characterized this type and variety of grape as the Lady Finger variety. There is additional evidence in the record showing the production and sale of Lady Fingers by various other persons. W. Flanders Setchel testified that he had a number of acres of Lady Finger grapes in the Carmelita Vineyard when he owned the same, and that these grapes were in bearing in the year 1915 (R. 86); that the product of his vines was shipped east and sold chiefly in New York and Chicago (R. 87); that in the years 1916, 1917 and 1918, he also shipped several carloads of Lady Finger grapes from the Lindsay district in Tulare County. (R. 87.)

Fernand de Journal testified that he undertook the management of the Carmelita Vineyards in 1921 (R. 90); that included in these vineyards was about twelve acres of Lady Finger grapes and that said grapes were known by that name by the trade and people generally (R. 91); that he first saw Lady Finger grapes in 1916 or 1917 when he visited the Carmelita Vineyard (R. 93).

Robert de Journal testified that he was a packer and shipper of fruit from Fresno County, and that he knew the variety of grapes called "Lady Fingers" (R. 94); that he had seen such grapes on the Carmelita Vineyard and also on the Frank H. Wilson Vineyard near Fresno (R. 95); that he had handled and shipped

said grapes under the name of Lady Fingers from Fresno County to eastern points. (R. 95).

In passing, it should be noted that a portion of the evidence cited in appellant's brief at first reading appears to stress unduly Mr. Humphrey's alleged attempts to prevent the use of the name. On page 25 of Brief for Appellants, the following portion of the record is quoted:

“Q. Who have you notified? A. The Earl Fruit Company and the California Fruit Exchange, who shipped about 12,000 cars I think a year. They have notified their representatives and have notified their growers to market the grapes under a name other than Lady Fingers.” (R. 62).

This statement of Mr. Humphrey's may be misleading; obviously, he means that the Earl Fruit Company and the California Fruit Exchange shipped about 12,000 cars of all varieties of grapes each year. It is clear from the record that there are not 12,000 cars of Lady Finger grapes grown each year in the State of California. Mr. Humphrey testifies (R. 42) that he has about 300 acres of Lady Finger grape vines and that he controls 90 per cent of the shipments. It is common knowledge that each carload of grapes contains from ten to twelve tons. Each acre of land produces about eight tons to the acre of Lady Finger grapes (R. 92). If it were true that 12,000 carloads of Lady Finger grapes were shipped by the fruit companies mentioned by Mr. Humphrey, that would mean that approximately 96,000 tons of grapes were shipped. This being ten percent of the shipments as testified to by

Mr. Humphrey, it would mean that the total number of tons of Lady Finger grapes shipped out of the State would be in the neighborhood of a million tons, which is potently erroneous.

In the case of *La Republique Francaise v. Saratoga Vichy Co.*, 191 U. S. 426, 446, the Supreme Court discusses the principle involved as follows:

“A serious difficulty in the way of enforcing an exclusive right on the part of the plaintiffs to the use of the word Vichy is their apparent acquiescence in such use by others. For thirty years the defendant, the Saratoga Vichy Company, has been openly and notoriously bottling and selling its waters under the name of the ‘Saratoga Vichy’ until its competition has become an extremely serious matter to the plaintiffs, whose importations began in 1853 with only 316 bottles, which by the year 1893 had increased to 298,500 bottles. The entire shipment of the Vichy company amounted in 1896 to nearly ten millions of bottles. Under such circumstances, and in view of the further facts that other waters were openly manufactured and sold in this country under the name of Vichy, and that a manufactured water was dealt out by the glass under that name in innumerable soda water fountains throughout the country, as shown by the record in this case, it is impossible to suppose that the plaintiffs were not aware of these infringements upon their exclusive rights. It argues much more than ordinary indifference and inattention to suppose that the large amount of this rival water could be advertised and sold all over the country without the knowledge of their agents, who would naturally be active in the protection of their own interests, if not the interests of their principals. In fact, they had allowed the name to become generic and indicative of the character of the water. With all these facts be-

fore them and with the yearly increasing sales and competition of the defendant company, no move was made against them for twenty five years, and until 1898, when this bill was filed. A clearer case of laches could hardly exist. *Saxlehner v. Eisner & M. Co.*, 179 U. S. 19, 45 L. ed. 60, 75, 21 Sup. St. Rep. 7."

In *National Starch Mfg. Co. v. Munn's Patent Maizena & Starch Co.*, (1894) A. C. 275, it was held that the neglect of an owner of a trade mark to register it for twenty-four years, coupled with his failure during that period to restrain its use by others as a term descriptive of the article, made the name *publici juris* and disentitled the owner to enjoin its use by another to denote the character and quality of the article. And in *Ford v. Foster*, L. R. 7 Ch. 628, 41 L. J. Ch. N. S. 682, it was held that the right to a trade-mark is lost so as to bar the owner from restraining its infringement where the name has come to be so public and in such universal use that no one can be deceived by the use of it or can be induced by such use to believe that he is buying the goods of the original trader.

In the instant case, Mr. Humphrey permitted nurserymen and grape growers to use the name "Lady Fingers" for many years without asserting the rights which he now claims. He has permitted grape growers to expend thousands of dollars in planting vineyards to Lady Finger grapes and to marketing the same. He can not now come before a court of equity and ask that these growers, who have expended large sums of money in developing their property and their markets, be denied the right and privilege of using

that name in shipping their product. Had Mr. Humphrey registered his trade-mark shortly after he adopted the name "Lady Finger," perhaps his delay in failing to enforce his alleged rights would seem more excusable, since the trade-mark registration, coupled with the announcement of that fact on labels used by him, would be some notice to the world of his claim. But by his own testimony Mr. Humphrey admits that almost thirty years elapsed between the time he first used the word "Lady Fingers" and the registration of the trade-mark.

The only reason for granting anyone a trade-mark is in order that such person may be protected for money expended in building up a business and in order that the general public may be protected in its purchases. Even if Mr. Humphrey had a valid right to a trade-mark in 1895, he lost that right, because for many years thereafter he permitted the general public to adopt that name to classify a variety and type of white grapes grown in California.

X. CONCLUSION

For all of the reasons heretofore advanced, we respectfully submit that the decree of the trial court should be approved and affirmed. No valid trade-mark ever existed. The term "Lady Finger" as applied to a variety and type of white grapes was commonly used and employed both in this country and in foreign countries long before the appellant or its predecessor in interest ever adopted or used it. The word "Lady Finger" as applied to these grapes has a generic meaning and is not subject to exclusive appropria-

tion by appellant or any other person. Furthermore, in view of the giving away of cuttings from the parent stock of this grape vine without any showing of a binding contract not to apply the name to the grapes grown from these cuttings, and the laches of appellant and its predecessor in interest, there could be no recovery in this suit and the decree should be affirmed.

Dated: June 21st, 1929.

Respectfully submitted

W. M. CONLEY,
PHILIP CONLEY,
MATTHEW CONLEY,
Attorneys for Appellees.